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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,246	07/20/2001	Chet L. Andrews	VLTI.79914	1646
5251 7590 04/05/2007 SHOOK, HARDY & BACON LLP INTELLECTUAL PROPERTY DEPARTMENT 2555 GRAND BLVD KANSAS CITY, MO 64108-2613			EXAMINER BORLINGHAUS, JASON M	
			ART UNIT 3693	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/05/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/910,246

Applicant(s)

ANDREWS ET AL.

Examiner

Jason M. Borlinghaus

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2007 and 10 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 2 is objected to because of the following informalities: unneeded word. Claim 2 states "further comprising the step of: generating of records and materials." (emphasis added). Examiner is unsure why Applicant has added the word "of".

Claims 4 – 6 and 10 - 12 are objected to because of the following informalities: lack of antecedent basis. Claim terminology alternates between "purchaser", "consumer" and "e-consumer".

Claims 8 – 9 and 15 - 16 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Mere possession of a computer readable medium or system capable of performing the method of parent claims, Claim 1 and 10, would infringe claim medium or system claims but not the method claim. See *MPEP* § 608.01(n).II and III. Applicant is required to cancel the claim(s) or rewrite the claim(s) in independent form.

Claim 11 is objected to because of the following informalities: improper word. Claim 11 states "displaying and MICR-line". (emphasis added). Examiner assumes that Applicant intends to claim "displaying an MICR-line".

Please examine all claims and, where required, correct appropriately.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 - 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Pollin (Us Patent 5,966,698) in view of Official Notice.

Regarding Claims 1 - 7, Pollin discloses a method for a payment settlement process that electronically originates a paper check settlement for transactions comprising the steps of:

- providing, a consumer (payor) interacting with a merchant (payee), an option to pay by check (paper bank draft). (see col. 6, lines 23 – 54);
- obtaining necessary personal and financial information to allow check creation (draft generation). (see col. 6, lines 23 – 54);
- obtaining a guarantee of the funds (check guarantee). (see col. 10, line 52 – col. 11, line 6);
- transferring check print information to a check printing apparatus (draft printer). (see col. 13, lines 55 - 67);

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- providing confirmation of transaction to all parties (payor receives notice letter and payment collector receives written authorization). (see col. 11, lines 45 – 56);
- wherein said check print information enables said check printing apparatus to print a paper check (printed draft) and deposit said paper check into the account of said merchant (payee's account). (col. 5, lines 4 – 35; col. 13, lines 55 - 67);
- further comprising generating records and materials necessary to effectuate a deposit of funds to the proper account (creditor identity). (see col. 5, lines 4 – 35);
- providing information on fund deposits (payee account information). (see col. 5, lines 4 – 35);
- transferring control and information (account information) to a host web server (networked database, such as when account information is verified). (see col. 5, lines 4 – 35);
- wherein said necessary personal and financial information to allow check creating is directly obtained from the consumer (debtor/payor). (see col. 7, line 35 – col. 8, line 6);
- wherein said necessary personal and financial information to allow check creation is recalled from a previous customer transaction (previously accrued debt/archival information). (see col. 7, line 35 – col. 8, line 6);

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- wherein said guarantee of funds (check guarantee) comprises the steps of sending purchase amount and personal information to a third party vendor (firm). (see col. 10, line 52 – col. 11, line 6);
- receiving a response (the guarantee) from the third party vendor. (see col. 10, line 52 – col. 11, line 6);
- displaying said response (verification response) to the purchaser (operator). (col. 10, line 52 – col. 11, line 17);
- prompting purchaser (payor) for final acceptance of transaction (execution of draft/signing of draft by payor). (col. 6, lines 23 – 54);
- posting a payment transaction to a database server (archival information). (see col. 8, lines 6 – 18);
- forwarding an merchant transaction tag (transaction information) and third party approval (verification) to a merchant (payee);
- obtaining said merchant (payee) instructions to print (execute) a paper check (draft). (see col. 13, lines 39 – 48);
- depositing said paper check (draft) into the account of said merchant (payee). (see col. 5, lines 4 – 35);

Pollin does not teach a method wherein the settlement is for online transactions between an e-consumer and a e-merchant; transferring check print information to and enabling the printing of the check at a check printing and depositing bank; selection of option to pay by check comprises selection of icon on e-merchant's web page; (emphasis added).

Examiner takes **Official Notice** that online transactions conducted between an e-consumer and an e-merchant, and the selection of a payment option for such transaction via selection of an icon on an e-merchant's website is old and well known in the art of e-commerce and online business.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Pollin to allow for the use of said check printing system with online transactions conducted between e-participants, utilizing the methodologies and/or systems standard and conventional to such online transactions, as is old and well known, as paper checks are still utilized as a form of payment within the e-commerce world.

Examiner takes **Official Notice** that transmission of check printing data to a bank for printing is old and well known in the art of the banking industry.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Pollin and Official Notice by incorporating the ability to print checks at a bank, as is old and well known, to allow for printing of checks at a centralized location, particularly a centralized location that traditionally has experience with the printing of such checks.

Regarding Claims 8 – 9, such Claims recite similar limitations as claimed in previously rejected claims, would have been obvious based upon previously rejected claims, or are otherwise disclosed by the prior art applied in previously rejected claims. Such claim limitations are therefore rejected using the same art and rationale as previously utilized.

Regarding Claims 10 – 14, Pollin discloses a method performed in a computer system having a graphical user interface including a display for displaying and a means for enabling entry of a plurality of purchaser (payor) informational items in the computer system. (see fig. 4 – 7; col. 8, lines 32 - 51) said method comprising:

- displaying a check image. (see fig. 4 – 7);
- displaying a plurality of labels (fields) and alphanumeric entry boxes (fields) for prompting and accepting said purchaser informational items wherein the purchaser (payee) informational items are used in electronic commerce to allow a paper check transaction between a consumer (payee) and a merchant (payor). (see fig. 4 – 7; col. 8, lines 32 – 51);
- wherein displaying of said check image comprises displaying: a purchaser (payee) name; a purchaser (payee) address; a check number; a check date; a check amount; a payee name; a MICR-line (ABA bank identification number and debtor's checking account number; and a signature entry (signature block). (see fig. 4 – 7);
- wherein the means for entry of information by a purchaser is with a keyboard. (see col. 8, lines 32 - 51);
- wherein the means for entry of information by a purchaser is on a displayed keypad (keyboard), wherein said keypad has a plurality of buttons and wherein said buttons depict characters and symbols found on a paper check. (see col. 8, lines 32 - 51); and

- wherein said check image is arranged and displayed in a similar format as a paper check. (see fig. 4 – 7).

Pollin does not teach that the method is used in electronic commerce between an e-consumer and an e-merchant. (emphasis added).

Examiner takes **Official Notice** that electronic commerce transactions conducted between an e-consumer and an e-merchant is old and well known in the art of e-commerce and online business.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Pollin to allow for the use of said check printing system with online transactions conducted between e-participants, as is old and well known, as paper checks are still utilized as a form of payment within the e-commerce world.

Regarding Claims 15 - 22, such Claims recite similar limitations as claimed in previously rejected claims, would have been obvious based upon previously rejected claims, or are otherwise disclosed by the prior art applied in previously rejected claims. Such claim limitations are therefore rejected using the same art and rationale as previously utilized.

As for differing claim limitations, Pollin does not teach charge back items nor the payment of fees to a guarantee service.

Examiner takes **Official Notice** that charge back items and refund requests, and the payment of fees to a guarantee service are old and well known in the financial and banking industries.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Pollin and Official Notice by incorporating such banking methodologies, as are old and well known, as such methodologies are standard and conventional in the art of banking.

Response to Arguments

Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

Regarding previous claim objections concerning Claims 8 – 9 and 15 – 16, Examiner asserts that dependent computer readable medium and system claims can be infringed upon without infringing upon the independent method claims.

For example, Claim 1 is for a method while Claim 8, a dependent claim, is the method encoded on a computer readable medium. The computer readable medium itself never performs any of the steps required by the method, although such medium has the potential to perform the method should it executed by a computer capable of reading such a medium. Therefore, mere possession of such a computer readable medium, even if not actually being executed, would infringe Claim 8, but such possession would not be enough to infringe upon Claim 1, as Claim 1 relates to the actual performance of the method.

Examiner's Note

The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 4/2/07
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